UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,924	06/05/2000	Gregory J. Wolff	074451.P119X	1296

7590 03/01/2004

EXAMINER
TRAN, MYLINH T

Michael J Mallie
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

ART UNIT	PAPER NUMBER
2174	8

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/589,924	Applicant(s) WOLFF ET AL.	
	Examiner Mylinh T Tran	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Amendment filed 12/04/03*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,15-21 and 27-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 15-21 and 27-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment filed 12/04/03 has been entered and carefully considered. Claims 1, 15, 28 and 34 have been amended. However, limitations of amended claims have not been found to be patentable over prior art of record and newly discovered prior art, therefore, claims 1-7, 15-21 and 27-37 are rejected under the new ground of rejection as set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 15-17 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al [US. 6,097,389] in view of Terao [US. 6,604,165].

As to claims 1, 15 and 28, Morris et al. discloses means for displaying the plurality of media objects in reduced visual representations in at least one track (figure 12C, column 5, lines 27-55 and column 14, lines12-23) and means for navigating among the reduced visual representations (column 6, lines 37-49 and column 13, lines 27-37). The difference between Morris et al. and the claim is means for accepting a cartridge

having a slot for receiving a removable a memory device to store a plurality of media objects. While Morris shows plurality of media objects, Terao teaches the cartridge having a slot for receiving a removable memory device at column 1, lines 30-38 "comprising a cartridge access station (CAS) 5, accessor (ACC) 6, and a plurality of cells (CELLs) 7. CAS 5 is a special cell for importing/exporting a recording medium to the library device and ....ACC 6 is a robot for transporting the recording medium within the library device, and the cells 7 are slots for storing recording media". It would have been obvious to one of ordinary skill in the art, having the teachings of Morris et al. and Terao before them at the time the invention was made to modify the memory storing a plurality of media objects as taught by Morris et al. to include a cartridge having a slot for a memory device of Terao in order to disclose "the cartridge having a slot for a memory device to store a plurality of media objects", with the motivation being for users to easily carry removable memory and be able to transfer the media object from the memory device to the cartridge as taught by Terao.

As to claims 2, 3, 16 and 17, while Morris et al. also discloses the plurality of media objects stored in the memory device (column 4, lines 55-65), Terao shows the method of the memory device being transferred to the cartridge and being inserted into the slot and the memory device being a flash memory card (column 7, lines 50-65).

As to claim 27, Morris et al. demonstrates displaying the plurality of media objects on a television screen (column 4, lines 12-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-7, 18-21 and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. [US. 6,097,389] in view of Terao and further in view of Jain et al. [US. 6,567,980].

As to claims 4 and 18, the difference between Morris et al., Terao and the claim is multiple tracks (third track) containing objects and stories. Jain et al. shows the feature at figure 17 while Morris et al. teaches imported objects and authored stories. It would have been obvious to one of ordinary skill in the art, having the teachings of Morris et al., Terao and Jain before them at the time the invention was made to modify the memory storing the first and second track of media objects as taught by Morris et al. and Terao to include the third track containing media objects, with the motivation being to display multiple digital image objects allowing the user to efficiently navigate through these objects in the storage as taught by Jain.

As to claim 5, while Terao shows means for accepting a cartridge having a slot for receiving a removable memory device, Morris et al. teaches the imported objects being provided from the memory device and comprise the imported stories (column 8, lines 38-55).

As to claims 6, 19, 20 and 30, while Jain et al. shows a third track, Morris et al. demonstrates means for selecting the media object from the first track and/or from the second track (column 2, lines 12-25 and column 5, lines 25-55); means for adding a representation of the selected media object (column 6, lines 25-48); and means for moving one of the authored stores to enable the user to edit the authored story (column 13, lines 15-60).

As to claims 7 and 21, Jain demonstrates means for selecting background music from a plurality of pre-recorded background music songs and means for associating the selected background music with the authored story (column 9, line 58 through column 10, line 8).

As to claims 33 and 35, while Terao shows means for accepting a cartridge having a slot for receiving a removable memory device, Morris et al. also discloses the memory device being a flash memory card (column 4, lines 40-67 and column 6, lines 15-38).

As to claim 29, while Jain shows the third track, Morris teaches the first and second track (figure 17).

As to claims 31 and 36, Morris et al. demonstrates the controller controls play of a plurality of authored stories, each authored story comprising the

plurality of media objects, wherein the authored story generated by the user using the controller to group related media objects (column 10, line 57 through column 11, line 45).

As to claims 32 and 37, while Morris et al. discloses the authored stories in the second track, Jain teaches the authored story in the third track being under construction (column 14, lines 28-67).

As to claim 34, the claim is analyzed as previously discussed with respect to claims 1 and 8.

Allowable Subject Matter

Claims 8-14 and 22-26 are objected to as being dependent upon a rejected base claim, but be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims would be allowable because the prior arts fail to teach or suggest "means for selecting comprise a game controller having a joystick and a plurality of control buttons".

Response to Arguments

Regarding claims 4-7 and 18-21, Applicant argues the references do not teach "means for selecting background music from a plurality of pre-recorded background music songs and means for associating the selected background music with the authored story". However, Jain's system discloses arranging tracks of media information and that is

enough for combination with the Morris's system. Applicant's attention is directed to column 9, line 59 of Jain "The analog audio signal is captured and digitized by audio digitization device, which may be any standard audio digitization device, such as a Sound Blaster audio card for a PC"...The normalized digital audio signal is then fed into an Audio Class Profiler which classifies the signal into one of several possible categories, such as "speed", "music", "silence", "applause", etc...". While Morris shows the stories being authored, Jain teaches the background music could be added to it. It is suggested by mixing tracks to make composite representation of the Jain's system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires fax a response, (703) 872-9306 for all kind of communications. NOTE, A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for information facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran whose telephone number is (703) 308-1304. The examiner can normally be reached on Monday-Thursday from 8.00AM to 6.30PM

If attempt to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Kristine Kincaid, can be reached on (703) 308-0640,

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Kristine Kincaid

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100